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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,999	11/19/2003	D. Michael Litscher	PC-1430	7586
23717	7590	08/11/2004	EXAMINER	
LAW OFFICES OF BRIAN S STEINBERGER 101 BREVARD AVENUE COCOA, FL 32922			EVANISKO, LESLIE J	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/716,999	Applicant(s) LITSCHER ET AL.	
	Examiner Leslie J. Evanisko	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10,12-15,17,19-21,24-26 and 28 is/are rejected.
- 7) ☒ Claim(s) 8,11,16,18,22,23 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/19/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference numerals **653** and **654** in Figures 13b, 15b, and 16b and reference numerals **820** and **830** in Figure 23 have not been described in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the

immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "**300**" in Figures 1 and 7a has been used to designate both the printer frame and the ball. It is noted that the ball has been defined in the specification (see page10, line 21, for example) with reference numeral "**200**" and shown in other Figures (such as Figure 22) as "**200**". Therefore, it is suggested that reference numeral "**300**" designating the ball structure in Figures 1 and 7a be changed to --**200**-- to be consistent with the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the floppy disk of claim 20 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in

the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 1-29 are objected to because of the following informalities:

With respect to claim 1, it is suggested that the phrase --having the non-planar, textured, and irregular surface-- in line 5 be moved to line 4 after the term "object" to insure the claim language is less awkward and it is clear that applicant is referring the surface of the object surface. Additionally, the phrase "a control unit for controlling the quantity of objects to be printed" is somewhat confusing since only a single object was previously recited throughout the claim. The term "a second and third axis" is grammatically incorrect and should be replaced with either --a second axis and a third axis-- or --second and third axes--. Furthermore, it is not clear why applicant refers to them as "second" and "third" since no first axis was previously recited. Note these problems with respect to the "axis" language also occur in claims 14 and 16-17.

With respect to claims 3-7, each of these claims is not a proper dependent claim in that each claim fails to further limit the structure recited in claim 1. In particular, it is noted that the indicia and object are not part of the claimed structure of the system of claim 1. Therefore, providing recitations regarding what type of indicia is being printed by the printing structure or what

type of object is being held in the fixture does not provide any further structural limitation of the system.

With respect to claim 14, the recitation of “areas of pre printed indicia” in line 6 is unclear since it provides no connection as to on what structure or where this indicia is located. To correct this problem, it is suggested that the phrase --and areas of pre printed indicia-- be inserted after “surface” in line 3 of claim 14.

With respect to claims 16 and 17, it is suggested that the term “a second and third axis” (emphasis added) be deleted and replaced with --the second axis and the third axis-- since the second and third axes were previously recited in claim 14.

With respect to claim 18, the term “said object with curved surface” has no proper antecedent basis since the object has not been previously defined as having a curved surface.

With respect to claim 21, it is noted that applicant refers to both plural non-planar, textured, and irregular surfaces (lines 1-2) and a singular non-planar surface (line 10) in the claim. It is suggested that applicant use consistent language throughout the claim.

With respect to claim 29, it is suggested that the term “cartridge” in line 4 be deleted and replaced with --cartridges-- to correct an obvious typographical error. Additionally, the claim has two periods at the end of the claim.

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-7, 10, 12, 14, 17, 19, 21, 24-26, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Loper et al. (US 2002/0097280 A1). Loper et al. teach a system and method for applying graphics to an object 20 having a pre-printed, non-planar, textured, and irregular surface comprising a fixture 21, 22, 23, 25 for receiving, holding, and rotating the object about a second axis and a third axis (rotating about horizontal axis by pivoting of member 25 and rotating about vertical axis by rotation of spindle 22--see paragraphs [0028 & [0038]], an indicia generating unit 27, 28 with an input for receiving indicia, means to generate and manipulate the indicia, and an output for applying the indicia to the object, a control unit for controlling the quantity of objects 20 to be printed and the movement of the object relative to the indicia-generating unit such that the object is maintained at a fixed position relative to the output of the indicia-generating unit, whereby indicia is applied to the surface of the object by positioning the object relative to the indicia-

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generating unit. Note that since the fixture, indicia generating unit, and control unit of Loper et al. are in a single device, they can broadly be considered to be located at a single station as recited.

With respect to claims 3-7 and 24, note paragraphs [0033], [0039], and [0048].

With respect to claims 12, 19, and 28, note paragraphs [0022]-[0023].

With respect to claim 14, note Loper et al. teach an indicia generating unit 27, 28, positioning means, control unit, support 21, 22 with base 25, and transfer means 30, 32, 35 as recited. Attention is invited to paragraph [0028] of page 2. Note the support 21 for the ball 20 can be pivoted on pivot frame 25, rotated on spindle 22 and moved linearly by slide 32.

With respect to claims 25-26, note paragraph [0032].

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any

inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 2, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loper et al. (US 2002/0097280 A1) in view of JP 11-320863. Loper et al. teach a device as recited, with the exception of the device being a free standing vending machine which accepts payment (either money via a bill acceptor or credit cards). JP 11-320863 teach a golf ball printing apparatus 1 configured as a vending machine which accepts money via coin slot 7. See Figure 1 and the English language abstract. In view of this teaching, it would have been obvious to one of ordinary skill in the art to configure the printing apparatus of Loper et al. as a vending machine in which a user inputs money to receive personalized printed objects. Furthermore, although JP '863 does not specifically teach a bill acceptor, the provision of a bill acceptor in a vending machine is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to provide a bill acceptor to allow for more payment options for the user who, for example, may not have any coins with which to pay.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loper et al. (US 2002/0097280 A1) in view of Stephenson (US 2002/0134257 A1). Loper et al. teach an apparatus as recited with the exception of having a multi-color inkjet cartridge. However, Stephenson teach a golf ball printing apparatus including a multi-color inkjet cartridge in paragraph [0029]. IN view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the apparatus of Loper et al. with a multi-color inkjet cartridge as taught by Stephenson as it would simply require the obvious substitution of one known cartridge arrangement for another to allow for a simpler and more efficient printing arrangement.

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loper et al. (US 2002/0097280 A1). Loper et al. teach an apparatus as recited with the exception of the computer receiving the image from a floppy disk. However, the use of a floppy disk to store digital images is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to provide the image information to the apparatus of Loper et al. from a floppy disk.

Allowable Subject Matter

13. Claim 29 is allowed. Note, however, the claim objections set forth above must be corrected to the satisfaction of the Examiner.

14. Claims 8, 11, 16, 18, 22-23, and 27 are objected to for the reasons set forth above as well as for being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the above objections to the satisfaction of the Examiner and in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 8, 11, 16, 22-23, and 29, the prior art of record fails to teach or fairly suggest an apparatus, system, and method for applying graphics to an object having a non-planar, textured, and irregular surface at a single station, having all of the structure (or method steps) recited, in combination with and particularly including, providing a gimbal assembly for holding the object in the station.

With respect to claims 18 and 27, the prior art of record fails to teach or fairly suggest an apparatus and method for applying graphics to an object having a non-planar, textured, and irregular surface at a single station, having

all of the structure (or method steps) recited, in combination with and particularly including, a rotatable and elevatable table for moving the object under the indicia generating unit.


Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Over et al. (US 6,538,767), Gordon et al. (US 5,632,205), Heene et al. (US 6,462,812), and JP 2002-337329 each teach a system, apparatus and method for printing golf balls having obvious similarities to the claimed subject matter.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
August 8, 2004